



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/670,236      | 09/26/2003  | Joachim Kuhn         | 740116-493          | 8557             |

22204 7590 12/13/2005

NIXON PEABODY, LLP  
401 9TH STREET, NW  
SUITE 900  
WASHINGTON, DC 20004-2128

EXAMINER

FIDEI, DAVID

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3728

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/670,236

Applicant(s)

KUHN ET AL.

Examiner

David T. Fidei

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 and 28 is/are rejected.
- 7) ☒ Claim(s) 25-27, 29 and 30 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/26/03 & 4/29/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Drawings*

1. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Ehrmanntraut (European document no. EP 1 177 984 A2). Applicant's attention is drawn to the European Patent Office search report of 16 January 2004 where EP 1 177 984 is cited as an "X" category in that the claimed subject matter cannot be considered novel thereover.

4. Claims 1, 2, 5, 6 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Danner, Jr. et al (Patent no. 5,316,171). A shipping frame having a plurality of sidewalls 14, a bottom wall 16 and a top wall 12 is disclosed, see col. 5, lines 18-21. Each of the panel 12-18 have basically the same configuration with vacuum insulation panels 24 lining the inside of the shipping box, see col. 5, lines 47-53.

As to claim 2, the vacuum insulation panels located on one wall touches the inside surface of the panel located on the other wall.

As to claim 5, the insulation panels are securely joined to the walls at 28, see figure 7.

As to claim 6 a bonding agent is described relative to members 24, 26, edge piece 28 and at locations 64, 66, e.g., see col. 6, lines 56, 57; col. 12, lines 42-44, 60-68. This bonding agent is considered the functional equivalent of cementing together.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 10-17, 24 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ehrmanntraut (European document no. EP 1 177 984 A2) as applied to claim 1 above, and further in view of Admitted prior art (Admission). Page 2, paragraph [0010] through paragraph [0014] describes evacuated panels with cores of conventional foam, mineral fibers and microporous silicic acid acquires. Paragraph [0038] describes commercially available heat storing mass that is introduced in shipping boxes to deliberately ensure increased temperature consistency. These container constructions are disclosed as pertinent concepts relevant teachings known to those skilled in the art that are taken to be "prior art" under the term Admissions.

The difference between claims 10-16, 24 and 28 is the shipping box of Ehrmanntraut (European document no. EP 1 177 984 A2) having the vacuum insulation panels resides in the features of the specific panel construction and a heat sink within the box. It would have been obvious to one skilled in the art at the time the invention was made to modify the shipping box of EP 1 177 984 A2 by employing panels as recited in claims 10-14 in view of the Admission, for the reason that such panels provide good thermo insulating properties. Similarly, with regard to claims 15 and 16 it would have been obvious to one skilled in the art at the time the invention was made to place a heat sink in the box in order to ensure increase temperature consistency within.

Art Unit: 3728

As to claim 17, a shock absorption system is provided in the shipping box by the vacuum insulation panels to the extent claimed.

7. Claims 1-24 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al (Patent no. 3,888,557) in view of Admission (Admitted prior art paragraph [0010] through paragraph [0014] and Paragraph [0038]). Anderson et al discloses an insulated container for a fire resistive filing cabinet. The container 11 has a shipping frame having a plurality of sidewalls, a bottom wall and a top wall is defined by the outer panels 35, 37 and 63. Foamed plastic panels 41 line the inside of the box. The difference between the claimed subject matter and Anderson et al resides in the box having vacuum insulation panels lining the inside.

The use of such panel for insulation purposes are known to those skilled in this art as acknowledge by the Admission. It would have been obvious to one skilled in the art at the time the invention was made to modify the container of Anderson by employing vacuum insulated panels, rather than mere foamed plastic 41, in order to provide enhanced thermal absorbing capabilities.

As to claims 2-4, figure 1 shows at least two layers with the joints offset transverse to one another, particularly on the bottom of the container 11.

As to claims 5-8, cementing the insulation panels to the walls would have been within the level of ordinary skill and obvious for the reason of securing the panels in place.

As to claim 9 nothing is mentioned in Anderson et al regarding panels 41 having projecting flaps.

As to claims 10-16, 24 and 28, these container constructions are disclosed as pertinent concepts relevant teachings known to those skilled in the art that are taken to be "prior art" under the term Admissions. Similarly, with regard to claims 15 and 16 it would have been obvious to one skilled in the art at the time the invention was made to place a heat sink in the box in order to ensure increase temperature consistency within.

As to claim 17, a shock absorption system is provided in the shipping box by the vacuum insulation panels to the extent claimed.

Art Unit: 3728

As to claims 18-22, Official Notice is taken that it is well known to keep valuables in heat resistant fireboxes such as jewelry items. Bracelets, necklaces or rings are stored in boxes having foam, fiber or felt padding. To place such a box in the of Anderson et al would have been a matter of intended use as the particular object placed in the file cabinet storage system is dependent upon what one desires to store.

As to claim 23, at least one layer of foam is provided between the innermost vacuum insulation panels and the shipping box.

8. Claims 1, 5, 6 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Putz (Patent no. 5,518,118) in view of Admission (Admitted prior art paragraph [0010] through paragraph [0014] and Paragraph [0038]). Putz discloses an insulated container 1 defining a frame with securing elements 7 made of plastic. The difference between the claimed subject matter and Putz resides in the box having vacuum insulation panels lining the inside.

The use of such panels for insulation purposes are known to those skilled in this art as acknowledge by the Admission. It would have been obvious to one skilled in the art at the time the invention was made to modify the container of Putz by employing vacuum insulated panels, in order to provide enhanced thermal absorbing capabilities.

As to claims 5 and 6, cementing the insulation panels to the walls would have been within the level of ordinary skill and obvious for the reason of securing the panels in place.

As to claim 31 a shipper holder 3 for holding a framed picture is defined within the box.

### ***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

10. Claims 4 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

Art Unit: 3728

regards as the invention. The joints of the bordering layer in claim 4 have no antecedent basis. In claim 20, the shock absorption layer has no antecedent basis.

***Allowable Subject Matter***

11. Claims 25, 26, 27, 29 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**REPLY BY APPLICANT OR PATENT OWNER TO THIS OFFICE ACTION**

“In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to every ground of objection and rejection in this Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. The applicant’s or patent owner’s reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. The reply must be reduced to writing (emphasis added)”, see 37 CFR 1.111 (b) & (c), M.P.E.P. 714.02.

Pointing out specific distinctions means clearly indicating in the written response what features/elements or distinctions have been added to the claim/claims, where support is found in the specification for such recitations and how these features are not shown, taught, obvious or inherent in the prior art.

If no amendments are made to claims as applicant or patent owner believes the claims are patentable without further modification, the reply must distinctly and specifically point out the supposed errors in the examiner's action and must respond to every ground of objection and rejection in the prior Office Action in the same vain as given above, 37 CFR 1.111 (b) & (c), M.P.E.P. 714.02.

The examiner also points out, due to the change in practice as affecting final rejections, older decisions on questions of prematureness of final rejection or admission of subsequent amendments do not necessarily reflect present practice. "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)" (emphasis mine), see MPEP 706.07(a).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fidei whose telephone number is (571) 272-4553. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The Official Fax number to file responses to this Office Action is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Art Unit: 3728

A handwritten signature in black ink, appearing to read 'D. T. Fidei', with a stylized flourish at the end.

David T. Fidei  
Primary Examiner  
Art Unit 3728

dtf  
December 8, 2005